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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/231,714      | 01/15/1999  | PATRICK E. PATTERSON | 09939/003001        | 2717             |

7590

09/29/2003

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EXAMINER

KANG, PAUL H

ART UNIT

PAPER NUMBER

2141

DATE MAILED: 09/29/2003

24

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/231,714

Applicant(s)

PATTERSON, PATRICK E.

Examiner

Paul H Kang

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the amendment filed August 19, 2003 (paper no. 22), the applicant cited pages 8-11 of the specification and Figures 2A-2D. However, the cited portions of the specification does not describe the newly added subject matter, nor can figures 2A-2D be found.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powell, US Pat. No. 6,067,526 in view of Gupta et al., US Pat. No. 6,484,156 B1, and further in view of Ruckdashel, US Pat. No. 6,144,942.

4. As to claims 1, 2, 4, 20, 21, 22 and 24, Powell teaches the invention substantially as claimed. Powell teaches a computer program and method of delivering electronic content, the computer program and method comprising:

providing instructions, including web page form instructions displayed on the browser upon selection of a link, that cause a first computer to transmit the first computer's or the user's e-mail address to a second computer in response to a request for a first information (Powell, col. 9, line 46 – col. 10, line 51 and col. 13, lines 5-46); and

processing the transmitted information at the second computer and selecting electronic content for transmission and transmitting the selected electronic content to the email address (Powell, col. 9, line 46 – col. 10, line 51 and col. 13, lines 5-46).

However, Powell does not explicitly teach dynamically transmitting the information to the second computer, wherein there is no manual user input of user information. Instead, Powell prompts the user to enter the e-mail and other information prior to transmitting the request (Powell, col. 13, lines 5-46).

In the same field of endeavor, Gupta teaches a system for dynamically transmitting user information to a remote server. Gupta transmits user information dynamically upon user instruction to "Add New Annotation". (see Gupta, col. 13, line 6-37).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated dynamic transmission of information, as taught by Gupta, into the system of Powell for the purpose of increasing the efficiency and user friendliness of the data transfer.

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Further, Powell-Gupta does not explicitly teach transmitting notification information when the electronic content is accessed at the first computer. In the same field of endeavor, Ruckdashel teaches transmitting a notification upon specified events (Ruckdashel, col. 1, line 13 – col. 2, line 15).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the notification system as taught by Ruckdashel into the system of Powell-Gupta for the purpose of enhancing user friendliness and effectiveness of the system.

5. As to claim 3, Powell-Gupta-Ruckdashel teach providing instructions comprising HTML instructions (Powell, col. 9, line 46 – col. 10, line 51 and col. 13, lines 5-46).

6. As to claim 5, Powell-Gupta-Ruckdashel teach the instructions that cause the first computer to collect information comprise instructions that query the first computer for information (Gupta, see Gupta, col. 13, line 6-37).

7. As to claim 6, Powell-Gupta-Ruckdashel teach the instructions that cause the first computer to collect information comprise instructions that receive user input (Powell, col. 13, lines 5-46).

8. As to claims 7 and 8, Powell-Gupta-Ruckdashel teach providing demographic and system information (Powell, col. 10, lines 5-34).

9. As to claims 9, Powell-Gupta-Ruckdashel teach processing the information comprising executing a script (Gupta, col. 9, lines 56-67).

10. As to claims 10, Powell-Gupta-Ruckdashel teach the invention substantially as claimed. However, Powell-Gupta does not explicitly teach processing the information comprising executing a CGI script on the first computer. As applied regarding claim 9, Powell-Gupta does teach the use of a script (Gupta, col. 9, lines 56-67).

Official Notice (MPEP 2144.03) is taken that implementation of CGI scripts in web based communications was well known at the time of the invention. Montulli, US Pat. No. 6,134,592, cited as relevant but not relied upon (paper no. 12), exemplifies the knowledge in the art at the time of the invention regarding the use of CGI scripts.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the use of CGI scripts into the system of Powell-Gupta-Ruckdashel for the purpose of using a widely accepted and robust programming code.

11. As to claim 11, Powell-Gupta-Ruckdashel teach the instructions remain at the first computer (Powell, col. 10, lines 5-34).

12. As to claim 12-16, Powell-Gupta-Ruckdashel teach a system wherein the electronic content comprises text, graphics, audio, video or executable instructions (Powell, col. 9, line 7 – col. 10, line 51 and col. 13, line 5 – col.14, line 33).

13. As to claims 17-19, Powell-Gupta-Ruckdashel teach a system wherein the information comprises selecting electronic content based on the transmitted information, and further comprising identification of the instructions and the computer that transmitted the information (Gupta, col. 13, line 6 – col. 14, line 38).

14. As to claim 23, Powell-Gupta-Ruckdashel teach a system wherein the instructions that cause the processor to select electronic content comprise instructions that cause the processor to use a table that indicates electronic content corresponding to data included in the received information (Powell, col. 16, lines 22-62).

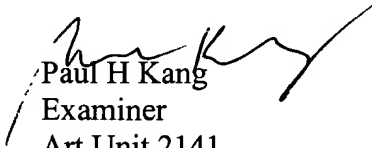
15. As to claims 25-27, Powell-Gupta-Ruckdashel teach transmitting a notification information when the requested data is subsequently accessed by third computer (Ruckdashel, col. 1, line 13 – col. 2, line 15).

16. Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection. The Applicant argued in substance that the prior art of record does not teach the newly added limitation “transmitting notification information when the electronic content is accessed.” The new grounds of rejection teaches this feature.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H Kang whose telephone number is (703) 308-6123. The examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Paul H Kang  
Examiner  
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